

U.S. Serial No. 10/661,748
Filed: September 12, 2003
Amendment and Response to Office Action dated 03/28/06

REMARKS

This Amendment is a full and timely response to the Office Action dated March 28, 2006.

Claims 1, 7, 9-11, 17, 31, 33, 36, 37, and 42-53 have been amended. Claims 42-53 have been renumbered to claims 41-52 to correct a numbering error. New claims 53-56 have been added. Upon entry of the present amendment, claims 1-56 will be pending in this application. No new matter is added, and support for the amendments may be found throughout the specification and in the original claims.

In the March 28, 2006 Office Action, the Examiner rejected all claims 1-53 and objected to claim 41. The Applicants respectfully traverse the Examiner's rejections and objection. For the reasons set forth below, the Applicants submit that the objection and rejections should be withdrawn and that the claims are in condition for allowance.

I. Claim Objection

Claim 41 was objected to as missing. This has been corrected. Claims 42-53 have been renumbered as claims 41-52, respectively, to correct the numbering error.

II. Claim Rejections – 35 U.S.C. § 101

The Office Action rejected claims 1-40 and 42-53 (now claims 1-52) under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter. The Examiner states that the claims are directed to non-statutory subject matter, because "the content of these claims is limited to an abstract idea, and does not constitute a statutory process, machine, manufacture or composition of matter in which the statutory process must result in a physical transformation in a computer system." Thus, the Examiner appears to be

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taking the position that the claims fall within a judicial exception (i.e., directed to an abstract idea) of statutory subject matter under 35 U.S.C. § 101. While the Applicants do not agree that the claims fall into this judicial exception or do not result in a physical transformation, this does not end the inquiry for a rejection under 35 U.S.C. § 101. Utility under 35 U.S.C. § 101 can also be found if the claimed invention produces a useful, concrete, and tangible result. *See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, Official Gazette Notices, 22 November 2005, <http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm> (hereinafter *Interim Guidelines*).

Claims 1-52 do produce a useful, concrete, and tangible result and, therefore, do meet the patentability requirement set out by § 101. The Federal Circuit has held that for a claimed invention to satisfy the requirements of 35 U.S.C. § 101, it must produce a “useful, concrete, and tangible result.” *State St. Bank & Tr. Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373-74 (Fed. Cir. 1998). In its *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, the USPTO states that the Examiner should weigh the aforementioned factors to determine whether 35 U.S.C. § 101 is met. *See Interim Guidelines*. Because the Applicants’ invention meets each of the three factors, as explained below, claims 1-52 are patentable under 35 U.S.C. § 101.

A. Useful

First, the Applicants’ claimed invention is useful. For this criterion to be met, the Patent Office requires a claimed invention’s utility to be “specific, substantial, and credible.” *See* M.P.E.P. § 2107(II)(A)(3); *Interim Guidelines*. The M.P.E.P. describes a “specific and substantial utility” as excluding “throw-away,” “insubstantial,” and

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“nonspecific” utilities. § 2107(II)(B)(1)(i). The Applicants’ claimed invention cannot be categorized as any of these three types of exclusions. Rather, it has the specific utility of improving the ranking of articles within search results. The claimed invention is useful, for example, in the context of a large volume of articles, such as the World Wide Web, because the large number of results from any given search query necessitates an effective way of ranking the results to determine which are most relevant. Therefore, the Applicants’ claimed invention is useful, because it has a specific and substantial utility.

B. Concrete

Second, the Applicants’ claimed invention is concrete. For this factor to be met “the process must have a result that can be substantially repeatable or the process must substantially produce the same result again.” *Interim Guidelines*. The Applicants’ claimed invention meets this criterion, because a ranking score for a first article is determined. When these methods are embodied and followed, the process of determining a ranking score for an article is repeatable. Therefore, the Applicants’ claimed invention is concrete, because it produces a result that is substantially repeatable.

C. Tangible

Third, the Applicants’ claimed invention is tangible. This requirement “does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing.” *Interim Guidelines*. Rather, the claim must set out a “practical application” that produces a “real-world result.” *Id.* The Applicants’ claimed invention sets out a practical application in claims 1 and 27 (and, thus, to their respective dependent claims) by determining a ranking score for a first article based at least in part on data associated with a first related

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query. The ranking score can be used to rank articles identified relevant to a search query. Thus, because the Applicants' claimed invention has a practical application and produces real-world results, the claimed invention is tangible.

Therefore, because each of the three criteria for patentability under § 101 are met, the Office Action rejection to these claims is believed to be traversed, and claims 1-52 are in condition for allowance.

III. Claim Rejections – 35 U.S.C. § 102

In the Office Action, claims 1-40 and 42-53 (now claims 1-52) stand rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent Application Publication No. 2004/0186828 ("Yadav"). In order to anticipate a claim under 35 U.S.C. § 102(e), "the reference must teach each and every element of the claim." M.P.E.P. § 2131. Yadav does not teach or suggest all of the elements of any of the Applicants' claims. Thus, the Applicants respectfully traverse these rejections.

Yadav is aimed at the problem of a user entering multiple queries into a search engine in order to obtain desired information. Yadav, thus, discloses creating an enhanced search query based on a user's search query. Specifically, Yadav discloses a method that "receives the query input by [the] user," "identif[ies] one or more terms related to each keyword and . . . synonyms of each keyword," and "allows a user to select one or more of the displayed synonyms and/or one or more of the listed related terms." See Yadav App. ¶¶ 38-42. Yadav further discloses that the enhanced query is used to identify relevant documents and the relevant documents are then ranked. Yadav discloses scoring and ranking documents returned for an enhanced search query based on the content of the documents, such as "based on particular criteria, such as proximity to

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the query term and the number of exact matches, proximity and frequency of synonyms, the location of these terms in the document.” *See* Yadav App. ¶ 59. Yadav does not disclose using the original query received to determine associated articles or ranking an article associated with the original query based on data associated with a related query.

Claims 1 and 27 both include elements for “determining a first article associated with the search query.” This search query is the search query received and the search query that a related query is determined related to. In contrast, Yadav does not determine articles related to the received search query. Rather, Yadav identifies documents relevant to the enhanced search query created by the user with help from the system disclosed in Yadav.

Moreover, claims 1 and 27 include elements that “determin[e] a first ranking score for the first article based at least in part on data associated with the first related query.” Yadav does not rank articles based on data associated with related queries. Rather, Yadav ranks the documents based on the content of the documents themselves, such as the number of keywords and the position of the keywords in the document. Moreover, the background of the present application states that this method of ranking using the content of the article disclosed in Yadav is used by conventional search engines to score or rank documents. *See* ¶2. In other words, the present invention is an improvement over this conventional ranking technique.

Since Yadav does not include all of the elements of claims 1 and 27, the Applicants respectfully request that the Examiner withdraw the rejection of claims 1 and 27.

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Claims 2-26 and 28-52 depend from claims 1 and 27 respectively and are patentable over Yadav for at least the same reasons as stated above for claims 1 and 27. Therefore, the Applicants respectfully request that the Examiner withdraw the rejection of claims 2-26 and 28-52.

IV. New Claims 53-56

New claims 53-56 have been added. Applicants believe that new claims 53-56 are in condition for allowance.

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CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action of March 28, 2006. Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner believes that there are any issues that can be resolved by a telephone conference, or that there are any informalities that can be corrected by an amendment, please call 404 815 6061.

Respectfully submitted,



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